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EXAMINER

HARBECK, TIMOTHY M

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/827,132
Filing Date: April 03, 2001
Appellant(s): SZE, VICKY

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/20/2006 appealing from the Office action mailed 2/13/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,141,653	Conklin et al.	10-2000
US 2001/0037204 A1	Horn et al.	01- 2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al (hereinafter Conklin, US PAT 6,141,653) in view of Horn et al. (hereinafter Horn, US 2001/0037204 A1).

Re Claim 1: Conklin discloses a method for interactive multivariate negotiations over a network including:

- Recording establishment of a commerce transaction agreement between a first and second parties for purchase of an offering, wherein the commerce transaction agreement is established utilizing a network based transaction system and wherein the commerce transaction agreement imposed first and second obligations on the first and second parties (see abstract)

Conklin does not explicitly disclose the step of

- Automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement

Horn discloses a system and method for online resolution of disputes wherein "the system is designed to minimize overhead costs by automatically reminding the parties of a pending settlement offer" (Page 2, Paragraph 0017)

It would have been obvious to someone skilled in the ordinary art at the time of invention to include the reminder feature taught by Horn to the system of Conklin to eliminate the need for constant follow up correspondence and telephone calls by one party to the transaction should the other default on the agreement.

(10) Response to Argument

The crux of appellant's argument with respect to independent claim 1 is simply that the combination of the references do not teach or suggest each and every element of the claim (Brief, page 10). Specifically, appellant claims that the references do not disclose the limitation that reads

Automatically presenting a reminder option to the first party that is exercisable by the first party to remind the second party to comply with the obligations of the second party imposed under the commerce transaction agreement.

The examiner has cited the Horn reference as prior art with respect to this limitation. Appellant claims that 'the language of Horn clearly indicates the reminders are for a pending offer to settle a dispute and are automatically generated. Additionally, there is nothing in the user interface screenshots of Horn to indicate an exercisable option exists.' (Brief Page 12). The examiner disagrees.

As to appellants point that the reminders for a pending offer are 'automatically generated' in Horn, this is also the case in the claimed language of the present invention ('automatically presenting a reminder option'). Respectfully, the portion of Horn cited by Appellant, with regards to the 'automatic reminder' (paragraph 0027) is not the portion relied upon in the rejection. The correct citation for Horn, is paragraph 0017, which reads 'One embodiment of the system is designed to minimized overhead costs by automatically reminding the parties of a pending settlement offer at selected time intervals, thereby eliminating the need for constant follow up correspondence and telephone calls (Horn paragraph 0017).' In other words, the system initially sends a reminder to the parties about a pending obligation, exactly as in the present invention. The examiner fails to see how these steps differ. Paragraph 0027, cited by Appellant refers to a scenario that occurs (after the initial reminder) if the 'second party' does not respond to the first party's (initiating party's) attempt to negotiate. It should be noted though this actually strengthens the Examiner's contention (in the following paragraph) that there is a first party that exercise a reminder option (i.e. initiates) to a second party (i.e. respondent), however it is not relevant to this first argument.

As per the second half of Appellants argument that the reminder is not 'exercisable' by the first party to remind the second party, the examiner also disagrees. Horn discloses that one party of the transaction further 'initiates the negotiation process' (Horn paragraph 0020), enters information about the dispute (Horn paragraph 0020), as well as selected parameters that are acceptable for settlement (paragraph 0021). Finally this information is used to contact the adverse party to invite said adverse party

to participate in the settlement (paragraph 0022). Therefore in an embodiment of Horn, two parties (for the sake of consistency 'first party' and 'second party') receive an automatic reminder option. This satisfies the first aspect of the limitation in question (the fact that the second party is also notified is irrelevant as the claimed limitation of 'the first party' receiving a reminder is met, but no exclusion of the second party also receiving the reminder option). The 'first party' then has an additional option (i.e. an exercisable option of the system) to contact the second party to remind them to comply with obligations (namely complete the transaction in question).

Therefore the examiner maintains his stance that a 'first party' of Horn receives an automatic initial system reminder option (paragraph 0017). The first party then has a further ability to 'exercise' this reminder option, via the system, to contact 'the second party' to remind them to comply (paragraphs 0020-0023).

As per appellants arguments concerning claims 2 and 19 (Brief page 12), the examiner maintains that Horn discloses the disputed limitation. Further evidence that Horn discloses 'automatically presenting a reminder option a predetermined interval after establishment of the commerce transaction agreement between the first and second parties' can be found in paragraphs 0017 (automatically reminding the parties of a pending settlement offer at selected time intervals).

Appellant has made no contentions with respect to the Conklin reference, or with respect to the motivation to combine the references. The examiner thus maintains the rejections, since it has been shown that the references (Conklin and Horn) disclose each and every limitation, and there is proper motivation to combine.

Furthermore, The Federal Circuit has stated that 'Although our predecessor court was the first to articulate the motivation-suggestion-teaching test, a related test—the "analogous art" test—has long been part of the primary Graham analysis articulated by the Supreme Court. See *Dann*, 425 U.S. at 227-29; *Graham*, 383 U.S. at 35.2 The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In *re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* ("[I]t is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

In this instance the examiner further contends that the prior art also passes the 'analogous art' test as the references are pertinent to the problem with which the applicant is concerned. *Conklin* deals with the establishment and recording of commerce transactions between parties (*Conklin Abstract*). *Horn*, likewise, deals with commercial transactions, and more specifically disputes (e.g. non payments) that arise over agreed upon obligations of said commercial transactions. The present invention recites ' A method to facilitate a network-based commerce transaction commences with the recording of a transaction agreement (e.g., a item purchase transaction) between a buyer and a seller. The transaction agreement is established utilizing a network-based

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transaction system (e.g. an online auction facility)' (present invention Abstract). In addition 'By automatically prompting sellers to issue reminders to buyers a predetermined time period after the establishment of a commerce transaction, for example, the number of occurrences of non-paying buyers may be reduced.' (Present invention, Abstract). Therefore it appears that the references not only provide appropriate motivation but also pass the analogous art test.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Timothy M. Harbeck




Conferees:

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SUPERVISORY PATENT EXAMINER



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